

REMARKS

In the Office Action dated November 29, 2005 ("OA"), the Examiner withdrew the allowance of claims 1-10, 12, 13, 15, 16, and 18-22. Instead, the Examiner rejected claims 1-10, 12, 13, 15, 16, and 18-22 under 35 U.S.C. § 103(a) as unpatentable over May et al., "Reducing the Peak-to-Average Power Ratio In OFDM Radio Transmission Systems," (*May*) in view of U.S. Patent No. 6,141,390 to Cova (*Cova*).

The Examiner also requested that the Applicants submit a supplemental oath/declaration. Applicants respectfully request that the Examiner allow Applicants to file a supplemental oath/declaration when claims have been allowed.

No new matter is added in this Amendment. Applicants cancel claim 1 and rewrite claims 5, 11, 14, and 15, which previously depended on claim 1, in independent form. Applicants also cancel independent claim 16 and rewrite claims 18, 19, and 21, which previously depended on claim 15, in independent form. Applicants also change the dependencies of claims 2, 3, 13, 17, and 22. Further, Applicants amend claims 23-29 to restore them to their as-issued state.

New claim 41 is identical in scope to issued claim 1, but for the addition of "a delay element coupled between said pulse-spreading filter and said combining circuit." New claims 42-56 depend on claim 41 and correspond to issued claims 2-15.

New claim 57 is identical in scope to issued claim 16, but for the addition of "delaying said filtered signal stream." New claims 58-64 depend on claim 57 and correspond to issued claims 17-22.

The Examiner previously allowed 1-10, 12, 13, 15, 16, and 18-22. See Office Action mailed July 30, 2004, at 1. The Examiner subsequently withdrew the allowance

of these claims “in view of the inventor’s evidence, filed on 7/6/05,” i.e., the “Inventor’s Submission under 37 C.F.R. 1.56,” and based the new rejection on the Inventor’s Submission. See OA at 2, ¶ 1.

The Examiner’s rejection was directed to independent claims 1 and 16, which have been canceled. Amended independent claims 5 and 18, however, now recite the “delay” feature discussed by the Examiner in the rejection. Amended claim 5 recites a plurality of elements including, among other things, “a delay element coupled between said first pulse-spreading filter and said combining circuit.” The Examiner alleges that *May* inherently discloses the claimed “delay element.” See OA at 2, ¶ 5. To support this allegation, the Examiner relies solely on the opinion expressed in the Inventor’s Submission:

Since the pulse-shape extends in both directions in time from the point at which its peak occurs, the teaching clearly requires that the input signal is delayed by at least half of the pulse-shape duration. In view of the foregoing, it is clear that *May*’s approach inherently uses a delay; in my opinion it cannot be done any other way. . . . *May* clearly teaches that the scaled bandlimited pulse-shape must be time aligned so that the pulse peak and the signal peak are time-coincident

Id. at 1-2 (underlining added and removed; citations omitted). Applicants, however, disagree with this and other opinions expressed in the Inventor’s Submission. Even if *May* inherently disclosed “that the input signal is delayed by at least half of the pulse-shape duration,” which it does not, *May* would not enable one of ordinary skill in the art to carry out the claimed invention. In fact, *May* does not disclose *how* to delay “the input signal.” Further, *May* does not disclose *how* to time-align the scaled band-limited

pulse-shape “so that the pulse peak and the signal peak are time-coincident.” In fact, the alleged delay in *May* to make “the pulse peak and the signal peak . . . time-coincident” would be *variable*. See Affidavit of Dr. Neil Birch. Further, one of ordinary skill in the art would not be able to enable the delay in *May* (a *variable* delay) without undue experimentation. See Affidavit of Dr. Neil Birch.

At best, therefore, *May* can only be used as a reference under § 103 with respect to the “delay element,” as recited in claim 5. See M.P.E.P. § 2121.01; *Elan Pharm., Inc. v. Mayo Found. For Med. Educ. & Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003) (“A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.”); see also *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991) (stating “a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103.”). The Examiner, however, has not alleged that the “delay element” recited in claim 1 is obvious in view of *May* or *Cova*. Further, enabling the variable delay in *May* is beyond the skill of one of ordinary skill in the art. See Affidavit of Dr. Neil Birch.

On the other hand, one embodiment in the Applicants’ specification enables “a delay element” by disclosing a fixed delay element. See Fig. 2, element 138 (“Delay Element”). Applicants’ note, however, that claim 5 is not limited to a fixed delay.

Applicants also believe it is improper for the Examiner to rely on an un-sworn “Submission” from the inventor. In fact, the inventor Ronald D. McCallister is not affiliated with the Assignee of this application. Further, from the Inventor’s Submission,

it appears as though Mr. McCallister is represented by counsel, but it is unclear who this counsel is and if he or she is a member of the patent bar.

For at least the above reasons, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 5 under § 103(a).

Claims 2-4 and 6-10 depend on claim 5 and include all the limitations of claim 5. Thus, for the reasons set forth above, claim 2-4 and 6-10 are not obvious in view of *May* and *Cova*. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 2-4 and 6-10 under § 103(a).

Although claim 18 is of different scope than claim 5, claim 18 has some features in common with claim 5. For example, claim 18 recites a combination of elements including, among other things, "said transmission method additionally comprises the step of delaying said filtered signal stream to produce a delayed signal stream." Thus, claim 18 is allowable at least for the same reasons as claim 5. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 16 under § 103(a).

Claims 17 and 22 depend on claim 18 and include all its limitations. Therefore, claims 17 and 22 are allowable for at least the same reasons as claim 18. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 17 and 22 under § 103(a).

Further, nowhere does the Examiner allege that either *May* or *Cova* disclose or suggest the elements of claims 2-4, 6-15, 17, or 19-22. The Examiner states, "Applicant representative admitted that *May et al* teaches every feature of the claimed invention but does not teach the inclusion of a linearizer or linearizing limitations in all the claims

either directly or through dependency.” Applicants respectfully disagree with the Examiner’s restatement of Applicants’ position. With respect to *May*, Applicants have only referred to the “broadest claims,” i.e., more than one independent claim. See, e.g., Reissue Application Declaration. Applicants respectfully request that the Examiner indicate where in *May* or *Cova* the Examiner alleges the prior art teaches the features of claims 2-4, 6-15, 17, and 19-22. Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 2-4, 6-15, 17, and 19-22 under § 103(a). In addition, Applicants assert that independent claims 11, 14, 15, 19, and 21, and the claims that depend on them, are patentable in view of the prior art of record.

Applicants request that the Examiner also consider new claims 38-64 and reinstated claims 23-29. New claims 38-64 and reinstated claims 23-29 are also patentable in view of the prior art of record.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: May 30, 2006

By: 
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Attachments: Declaration Under 37 C.F.R. § 1.132